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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,364	01/08/2001	Albert W. Chan	6136-53650	6620
30764	7590	10/27/2003	EXAMINER	
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP 333 SOUTH HOPE STREET 48TH FLOOR LOS ANGELES, CA 90071-1448			HARAN, JOHN T	
		ART UNIT	PAPER NUMBER	
		1733		

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/075,547	ULBRICH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Marc A Patterson	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 18 July 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-11 and 18-23 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-11 and 18-23 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### **Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 – 11 and 18 – 23, drawn to a labeled container, classified in class 428, subclass 34.1.
  - II. Claims 12 – 17, drawn to a process for labeling a container, classified in class 156, subclass 159.
2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a materially different method, such as providing adhesive on the edges of the web rather than on the adhesive tape.
3. Because these inventions are distinct for the reasons described above, and have acquired a separate status in the art because of their recognized different classification and subject matter, and because the searches required for the groups are not the same, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Thomas Durling on October 15, 2003 a provisional election was made with traverse to prosecute the invention of I, claims 1 – 11 and 18

– 23. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 12 – 17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5 – 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to Claim 5, the phrase 'characteristics selected to provide longitudinal and lateral shrinkage percentages for the splice tape that are substantially equal lateral and longitudinal shrinkage percentages for the splice tape' is indefinite as it is unclear what the characteristics are and how they are selected. For purposes of examination, the characteristics will be assumed to be any characteristics.

7. Claims 18 – 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to Claim 18, the phrase 'length of first and second web segments selected to provide a heat shrinkable container label having a closed cross section of a predetermined perimeter length' is indefinite as it is unclear what the length is. For purposes of examination, the length will be assumed to be any length. The phrase is also indefinite because the use of 'predetermined' has been held to be indefinite in a claim where it simply means

'determined beforehand'. *Joseph E. Seagram & Sons, Inc. v. Marzall, Comr. Pats.*, 84 USPQ 180 (Court of Appeals, District of Columbia).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 – 11 and 18 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (European Patent No. 0498249) in view of Rossini (U.S. Patent No. 5,658,420) and Wallace (European Patent No. 0023788).

With regard to Claims 1, 4, 6 11 and 18 – 23, Anderson et al disclose a heat shrinkable web (film; therefore having opposite edges with a length defined therebetween; page 2, lines 1 – 13) on which labels for containers are printed (page 2, lines 1 – 13). During the printing of the web and its label – to – container feeding operation, automatic flying splicing of a roll of expiring film to a new roll of film takes place in order for the operation to be continuous (page 8, lines 4 – 9); Anderson et al therefore disclose a label comprising first and second elongated webs, and the use of a splice member adapted to overlap a terminal portion of each of the webs with the web arranged in an abutting relationship, adhered to the ends of the webs over the printing thereon. Anderson et al fail to disclose a splice member which is heat – shrinkable, having an adhesive coating on its surface.

Rossini et al teach that it is well known in the art to use an adhesive tape as the splice member to form a flying splice between two webs (column 1, lines 34 – 48) for the purpose of joining the webs together quickly and accurately (column 3, lines 35 – 47). The desirability of providing for an adhesive tape (therefore a splice member having an adhesive coating on a surface of the splice member) in Anderson et al, which comprises two webs, would therefore be obvious to one of ordinary skill in the art.

Wallace teaches the use of a heat – shrinkable adhesive tape (patch; second paragraph, page 5) to adhere overlapping web edges (second paragraph, page 5) for the purpose of adhering web edges which are heat shrinkable (heat – recoverable; first paragraph, page 1). The desirability of providing for an adhesive tape which is heat shrinkable as the splice member in Anderson et al, in which heat shrinkable web edges are adhered, would therefore be obvious to one of ordinary skill in the art.

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for an adhesive tape in Anderson et al in order to join webs together quickly and accurately as taught by Rossini and to have provided for a heat – shrinkable adhesive tape in Anderson et al in order to adhere web edges which are heat shrinkable as taught by Wallace.

With regard to Claims 2 – 3 and 9, the tape which is taught by Wallace comprises polyethylene crosslinked by irradiation (second paragraph, page 14 of Wallace) and is therefore transparent.

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With regard to Claim 5, 7 – 8 and 10, the web which is disclosed by Anderson et al is a laminate of two plies of polypropylene film (page 7, lines 35 – 38) and the tape which is taught by Wallace is shrinkable as discussed above, and therefore shrinks bi – directionally.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (703) 305-3537. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (703) 308-4251. FAX communications should be sent to (703) 872-9310. FAXs received after 4 P.M. will not be processed until the following business day.

Marc A. Patterson, PhD.

*Marc Patterson*

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*Harold Pyon*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

10/20/03